

Remarks

Elections/Restrictions

Applicants acknowledge and thank the Examiner for rejoining claims 1-5, 7-13, 15-67, and 113-125, which had been subject to restriction in the Restriction Requirement mailed September 11, 2006, into a single group.

Withdrawn Rejections

Applicants acknowledge and thank the Examiner for withdrawing the rejections under 102(e) and 103 based on Baglin and the rejections under 102 and 103 based on Gombinsky.

Rejections under 35 U.S.C. § 112

Claims 1, 2, 4, 5, 7-13, 15-58, 113-115, 119, and 120 stand rejected under 35 U.S.C. 112, second paragraph as allegedly being indefinite. The Examiner states that, "Claim 1 recites that the gap is occupancy by magnetic particles prior to introduction of magnetic particles to the device, which is confusing because it seems that the particles are already on the device when they are in the gap." (Office Action, p. 4). Applicants find the rejection unclear and respectfully traverse. Applicants respectfully submit that claim 1 does not recite that the gap is occupancy by (or occupied by) magnetic particles prior to introduction of magnetic particles to the device. Instead, claim 1 recites that, "the gaps are *available* for fluid flow among them and *for occupancy* by magnetic particles prior to introduction of magnetic particles to the device" (emphasis added). Applicants submit that it is clear that the word "available" modifies both the phrases "for fluid flow" and "for occupancy". Thus the language of claim 1 indicates that, prior to introduction of magnetic particles to the device, the gaps are *available for occupancy* by magnetic particles. Applicants have amended claims 1 and 5 by adding the words "are also available" directly before the words "for occupancy". Applicants respectfully submit that the claim language clearly indicates that, when the device is configured for forming an array of magnetic particles (e.g., at the time the particles are introduced to the device) the gaps are not filled or obstructed with material in a way that would prevent particles introduced to the device from entering the gaps. Once particles are introduced to the device, at least some of the particles are trapped in gaps by the localized magnetic fields, so that those gaps are "occupied".

Applicants respectfully submit that claim 1 is not indefinite or confusing and respectfully request withdrawal of the rejection of claims 1, 5, and claims dependent thereon.

Claim Rejections and Allowable Subject Matter

Claims 1-5, 7-13, 15-32, 35, 38-41, 59, 61-63, 65-67, and 113-125 stand rejected under 35 U.S.C. §102 as being anticipated by Corney (claims 1, 2, 4, 5, 7, 8, 12, 13, 15, 30-32, 35, 38-41, 122), Baglin (claim 122), Andresen (claim 123), or Blankenstein (claim 124) or stand rejected under 35 U.S.C. §103 as being unpatentable over Corney (10, 11, 16-29, 62, 66, 113-121, and 125) or over Corney in view of Baselt (claims 3, 59, 61, 63, 65, 67), as set forth in the Detailed Action portion of the Office Action. Applicants respectfully traverse these rejections. Applicants note that the Office Action Summary and Index of Claims are inconsistent with the Detailed Action in their listing of allowed claims. Applicants base their response on the Detailed Action portion of the Office Action, which the Examiner confirmed to be correct, rather than on the Office Action Summary and Index of Claims. All references to the Office Action in the remarks below reflect the content of the Detailed Action.

Applicants continue to maintain that all pending claims, as examined, are novel and nonobvious. However, solely in the interests of advancing prosecution, and without waiver, disclaimer, or prejudice, Applicants have amended claims 1, 3, 5, 33, 34, 36, 42, 43, 44, 45, and 59 and canceled claims 7, 9, 60, 116-118, and 121-125. The Detailed Action indicated that claims 9, 33, 34, 36, 42-58, 60, and 64 constitute allowable subject matter (Office Action, p. 9). Applicants submit that all pending independent claims, as amended, are drawn to subject matter that the Examiner acknowledged as being free of prior art and allowable.

Claims 1, 3, 5, 33, 34, 36, 42, 43, 44, 45, and 59, have been amended as follows:

The Office Action stated that claim 9 was drawn to allowable subject matter. Claim 9, as examined, depended on claim 7, which depended on claims 1, 2, 3, or 5. Applicants have amended independent claims 1, 3, and 5 to include the limitations of claims 7 and 9 and have canceled claims 7 and 9. Amended claims 1, 3, and 5 are equivalent to rewriting claim 9 as three independent claims, each including the limitations of claim 7 and the limitations of either claim 1, 3, or 5 (as examined in the Office Action), respectively. Applicants respectfully submit that claims 1, 3, and 5 as amended, are drawn to subject matter acknowledged by the Examiner to be

allowable. Withdrawal of the rejection of claims 1, 3, 5, and claims dependent thereon (claims 2, 4, 8, 10-13, 15-32, 35, 37-41, 58, 113-115 (in part), and 119-120), is respectfully requested.

The Office Action stated that claim 33 (which was dependent on claim 1) was drawn to allowable subject matter. Applicants have rewritten claim 33 as an independent claim incorporating the limitations of claim 1 (as examined in the Office Action) and have amended claim 34 to depend on claim 33, so as to include the limitations of claim 1 (as examined in the Office Action). Applicants have also added the words “are also available” directly before the words “for occupancy” in claim 33, as described above for claim 1. Applicants respectfully submit that claim 33, as amended, is drawn to subject matter acknowledged by the Examiner as being allowable. Withdrawal of the rejection of claims 33 and 34 is respectfully requested.

The Office Action stated that claim 36 was drawn to allowable subject matter. Claim 36, as examined, depended on claim 32, which depended on 1. Applicants have rewritten claim 36 as an independent claim incorporating the limitations of claim 1. Applicants have also added the words “are also available” directly before the words “for occupancy” in claim 36, as described above for claim 1. Applicants submit that including the limitation of intervening claim 32 (“wherein the substrate comprises a nonmagnetic material”) in addition to the limitation that the substrate comprises silicon would be superfluous since the specification indicates that silicon is a nonmagnetic material (see specification, paragraph 114). Applicants respectfully submit that claim 36, as amended, is drawn to subject matter that the Examiner acknowledged to be allowable and respectfully request withdrawal of the rejection of claim 36.

The Office Action indicated that claims 42, 43, 44, and 45 were drawn to allowable subject matter. Each of these claims, as examined, depended on claim 1. Applicants have rewritten these claims to incorporate the limitations of claim 1 (as examined) and have added the words “are also available” directly before the words “for occupancy”, as described above for claim 1. Applicants respectfully submit that claims 42, 43, 44, and 45, as amended, are drawn to subject matter that the Examiner acknowledged to be allowable. Withdrawal of the rejection of claims 42, 43, 44, and 45, and claims dependent thereon (claims 46-57) is respectfully requested.

The Office Action indicated that claim 60 was drawn to allowable subject matter. Claim 60 depended on claim 59. Applicants have amended claim 59 to incorporate the limitations of claim 60 and have canceled claim 60. Applicants respectfully submit that claim 59, as amended, is equivalent to rewriting claim 60 as an independent claim incorporating the limitations of claim

59, and is thus directed to subject matter that the Examiner acknowledged to be allowable. Withdrawal of the rejection of claim 59 and claims dependent thereon (claims 61-67 and 113-115 (in part)) is respectfully requested.

In summary, Applicants respectfully submit that in view of the above amendments, the claims are now drawn to subject matter acknowledged by the Examiner to be allowable and free of the prior art. Withdrawal of the rejections under 35 U.S.C. §102 and §103 is respectfully requested.

In conclusion, in view of the amendments and remarks presented herein, Applicants respectfully submit that the present case is in condition for allowance. A Notice to that effect is respectfully requested.

If, at any time, it appears that a phone discussion would be helpful in resolving any remaining issues, the undersigned would appreciate the opportunity to discuss such issues at the Examiner's convenience. The undersigned can be contacted at (617) 248-5000.

A check in the amount of \$525.00 to cover the fee for a three (3) month extension of time is enclosed. Please charge any additional fees associated with this filing, or apply any credits, to our Deposit Account No. 03-1721.

Respectfully submitted,

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